

In re Application of: Gregg L. Sheddy  
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Filed: October 17, 2003  
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Attorney Docket No.: P-US-TN-3305

### REMARKS

The Office Action dated November 7, 2008, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 5 has been amended to correct a minor informality. No new matter is presented. Claims 1-5, 66-69, and 71 are pending with claims 1, 66, and 67 being independent. Claims 66-69 have been allowed. Accordingly, claims 1-5 and 71 are respectfully submitted for consideration.

### Allowable Subject Matter

Applicant thanks the Examiner for allowing claims 66-69.

### 35 U.S.C. § 102 Rejection

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated by Edler (U.S. Patent No. 3,302,669). Claims 2-4 depend from claim 1. The Applicant traverses the rejection and respectfully submits that claims 1-4 recite subject matter that is neither disclosed nor suggested by Edler.

Claim 1 recites, in part:

a first rail disposed on the frame assembly, the first rail having a longitudinal axis; a saw assembly disposed on at least one of the base and the frame assembly, the saw assembly comprising a support assembly, a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a cutting wheel driven by the motor assembly, the cutting wheel having a plane substantially parallel to the pivot axis; a table slidably disposed on the first rail so as to be movable relative to the saw assembly in a direction substantially parallel to the longitudinal axis

With respect to claim 1, the Office Action asserted that the bars 52 in Edler, the outer rail 250, the motor assembly 310a, and element 80 were comparable to the claimed first rail, support assembly, motor assembly, and frame assembly, respectively. See paragraph 3 of the Office

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Action. The Applicant respectfully submits however, that Edler does not disclose or suggest the arrangement of elements as recited in claim 1. Specifically, the bars 52 in Edler are not disclosed as being disposed on the element 80. In contrast, the bars 52 in Edler are part of the miter guide fence assembly 50, which is "removably mounted on the table top." See column 5, lines 25-27 and Figure 1 of Edler. Thus, the bars 52 in Edler are not disposed on element 80.

In addition, Edler does not disclose or suggest the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis. Specifically, the motor assembly 310a in Edler is not pivotable about a pivot axis substantially parallel to the longitudinal axis, as recited in claim 1. In contrast, the pivot axis in Edler is perpendicular to the longitudinal axis. See Figure 2 of Edler.

Further, Edler does not disclose or suggest a table slidably disposed on the first rail, as recited in claim 1. The Office Action asserted that the ridges 51 of the bars 52 were comparable to the claimed table. In contrast, Edler discloses that "[t]he bars [52] in each pile are mutually engaged by ridges 51 at the undersides of the bars ..." (Emphasis added). See Figure 1 and column 5, lines 26-29 of Edler. The Applicant submits, therefore, that there is no disclosure or suggestion in Edler that the ridges 51, which form part of the bars 52, are slidably disposed on the bars 52.

In view of the above, the Applicant respectfully submits that Edler does not disclose or suggest the features of the invention as recited in claim 1. To qualify as prior art under 35 U.S.C. § 102, each and every feature recited in a rejected claim must be disclosed by the applied art. As Edler does not disclose or suggest the features of the invention as recited in claim 1, the reference does not anticipate claim 1, nor is claim 1 obvious in view of Edler. Therefore, the Applicant submits that claim 1 is allowable over Edler and respectfully requests withdrawal of the rejection.

Claims 2-4 depend from claim 1 and are allowable for at least the same reasons.

**35 U.S.C. § 103 Rejections**

Claims 1-5 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto (U.S. Patent No. 4,985,544) in view of Hallenbeck (U.S. Patent No. 5,016,508).

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Miyamoto was cited for disclosing many of the claimed elements of the invention with the exception of a first rail disposed on the frame assembly the first rail having a longitudinal axis and a table slidably disposed on the first rail so as to be movable relative to the saw assembly in a direction substantially parallel to the longitudinal axis. Hallenbeck was cited for curing this deficiency. The Applicant traverses the rejection and respectfully submits that claims 1-5 and 71 recite subject matter that is neither disclosed nor suggested by the cited references.

Claim 1 recites, in part:

the saw assembly comprising a support assembly, a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a cutting wheel driven by the motor assembly

The Office Action asserted that the saw member 500 in Miyamoto was comparable to the claimed saw assembly, the guide arm 100 was comparable to the claimed support assembly, and that the motor case 515 was comparable to the claimed motor assembly. The Applicant respectfully submits however, that Miyamoto does not disclose or suggest at least the combination of features of a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly. In contrast, in Miyamoto, the motor case 515 does not pivot with respect to the guide arm 100. The motor case 515 in Miyamoto only slides along the guide arm 100. Miyamoto discloses "the radial arm saw of the present invention includes a saw member 500 supported on a mounting frame 200. A guide arm 100 supports and guides mounting frame 200 to move back and forth..." See Figure 1 and column 10, lines 48-51 of Miyamoto.

Further, in view of the above-described Miyamoto disclosure, the reference does not disclose or suggest a motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, as recited in claim 1.

Hallenbeck fails to cure the deficiencies in Miyamoto as Hallenbeck also does not disclose or suggest the features of a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor

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assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, as recited in claim 1. Accordingly, the combination of Miyamoto and Hallenbeck fails to disclose or suggest the features of the invention as recited in claim 1. Therefore, independent claim 1 is patentable over Miyamoto and Hallenbeck at least because neither reference describes or suggests each and every limitation of the claim. See MPEP § 2143.03 (citing In re Rovka, 490 F.2d 981 (CCPA 1974)).

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Edler. The Applicant traverses the rejection and respectfully submits that claim 5 recites subject matter that is neither disclosed nor suggested by the cited references.

Claim 5 depends from claim 1. As discussed above, Edler does not disclose or suggest the features of the invention as recited in claim 1. Therefore, the reference does not disclose or suggest the features of the invention as recited in dependent claim 5.

Claim 71 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyamoto in view of Hallenbeck and further in view of Karubian (U.S. Patent No. 3,703,654). Miyamoto and Hallenbeck were cited for disclosing many of the claimed elements of the invention with the exception of a switch that comprises a single throw, double pole switch. Karubian was cited for curing this deficiency. The Applicant traverses the rejection and respectfully submits that claim 71 recites subject matter that is neither disclosed nor suggested by the cited references.

Claim 71 depends from claim 1. As discussed above, the combination of Miyamoto and Hallenbeck does not disclose or suggest the features of the invention as recited in claim 1. Karubian fails to cure the deficiencies in Miyamoto and Hallenbeck, as Karubian also does not disclose or suggest the features of a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly, and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, as recited in claim 1. Therefore, the combination of Miyamoto, Hallenbeck, and Karubian do not disclose or suggest the features of the invention as recited in dependent claim 71.

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To establish a *prima facie* case of obviousness, each and every feature of a rejected claim must be taught or suggested by the applied art of record. See MPEP § 2143.03.

In view of the above, the Applicant respectfully submits that Edler and the combinations of Miyamoto and Hallenbeck, and Miyamoto, Hallenbeck and Karubian fail to support a *prima facie* case of obviousness for purposes of a rejection of claims 1-5 and 71 under 35 U.S.C. § 103. Accordingly, claims 1-5 and 71 are not rendered obvious in view of Edler and the combinations of Miyamoto and Hallenbeck, and Miyamoto, Hallenbeck and Karubian, and should be deemed allowable.

#### Conclusion

The Applicant does not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, the Applicant has not addressed all characterizations of the art, but reserves the right to do so in further prosecution of this or a subsequent application. Moreover, there may be alternative or additional reasons for patentability not discussed in this response.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's deposit account No. 02-2548, referencing Attorney Dkt. No. P-US-TN-3305.

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Respectfully submitted,

Date: \_\_\_\_\_

1/15/2009

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